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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,323	09/26/2003	Ryo Uehara	036568.02	5087

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OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
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EXAMINER
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HO, TUAN V

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,323	<b>Applicant(s)</b> UEHARA ET AL.	
	<b>Examiner</b> Tuan V. Ho	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/517,474.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 5, 6 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,292,217.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

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With regard to claim 1, claim 15 of Patet'217 discloses the claimed image device (image device inherently includes a n image sensor and recording device), selection device (selection device), output circuit (output circuit) and external monitor (output circuit inherently generates output signals in accordance with NTSC or PAL system; where the output in inherently displayed by a TV monitor the particular system), except that the recording medium records said digital data to said recording medium at a compression format, said recording medium can store a plurality of said compressed digital data, and said output circuit converts said compressed digital data to said image signals and outputs said image signals to an external monitor connected to the digital still camera in order to reproduce an image corresponding to said image signals.

Official Notice is taken for a recording medium that can store a plurality of compressed formats of image signals so as to accommodate for a plurality of user selections.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the recording medium of claim 1 in order to store a plurality of compressed image data in different formats because the modification of the recording medium of claim 1 would allow a user to record a plurality of a compressed digital signals in

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one recording medium instead of a plurality of recording medium thereby to provide a compact digital camera and convenience of the user.

Claims 5, 6 and 10 recite what was previously discussed with respect to claim 1.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the present abstract does not directly describe the claimed invention. Correction is required. See MPEP § 608.01(b).

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka cited by Applicants in view of Toyota et al cited by Applicants, further in view of Matoba et al cited by Applicants.

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With regard to claim 10, Tanaka discloses in Fig. 1, the image device (CCD 20, col. 3, line 19), recording device (CPU 50 and compress and extension circuit 34, col. 3, line 14 and col. 4, lines 8-20 and memory card 10), selection device (mode selection switch 51, col.4, lines 65-67 and col. 5, lines 1-12; noted that the selection of camera mode is not required to turn off the camera system), display (display 7, col. 3, line 40), and output circuit (CPU 50 and mode selection switch, col. 4, lines 39-50; noted that compression circuit 34 inherently includes a plurality of compression modes so as to compress the image data in accordance with a user selection), except for the display located on the camera body and plurality of processing systems including a NTSC and PAL systems.

Tanaka does not explicitly disclose the display located on the camera for indicating the selected signal and NTSC and PAL system. However, Toyoda et al teaches using display element 10 which is located on the camera C1 so as to display a plurality of camera modes (col. 21, lines 60+) and thereby to easily recognize a currently selected mode.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify monitor 7 of Tanaka so as to be located on the camera body as

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the same fashion as discussed by Toyoda et al and thereby to easily to select camera modes.

With regard to the NTSC and Pal system, furthermore, Matoba et al teaches using NTSC/PAL switch 21 (input terminal 21 is uses to switch camera modes such as NTSC mode and PAL mode, FIG.1 and col. 3, lines 45-56); wherein the selections of NTSC or PAL TV system allow the camera to be comparable with different TV systems (col. 2, lines 6-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the camera system of Tanaka in view of Toyoda et al in the same fashion as disclosed by Matoba et al, so as to obtain an input terminal which can select NTSC TV system or PAL TV system. This is because the modification of the system of Tanaka in view of Toyoda et al would allow a user to use the camera in different TV system and thereby to improve the versatility of the camera.

With regard to claim 1, Tanaka discloses in Fig. 1, the external monitor (monitor 7 is connected to the camera body via adapter 6).

With regard to claim 2, Tanaka discloses in Fig. 2, mode select switch 21 can select any of NTSC and PAL system while the display element 10 displays a current mode.



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With regard to claim 3, Tanaka discloses in Fig. 1, the memory card (memory card 10).

With regard to claim 4, Tanaka discloses in Fig. 1, mode select 51 which inherently selects either photographing mode or reproducing mode, col. 2, lines 5-30 and col. 4, lines 65-67 and col. 5, line 1+).

With regard to a frame number information superimposed on the image signal displayed on the external monitor, Tanaka in view of Toyoda et al further in view of Matoba et al does not disclose the frame number is superimposed on an image display. Official Notice is taken that an image is reproduced and displayed on monitor including a frame number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a frame number on the displayed image in order to easily recognize the order of the image and thereby more convenience to archive the image.

With regard to claim 5, Tanaka discloses in Fig. 1, the external monitor (monitor 7 is connected to the camera body via adapter 6).

Claims 6-9 recite what was previously discussed with respect to claims 1-4.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (572) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600.



TUAN HO

Primary Examiner

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